

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action transmitted April 24, 2008 ("*Office Action*"). Claims 1-25 are pending in the Application, and the Examiner rejects all pending claims. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

I. Rejections under 35 U.S.C. § 112

The Examiner rejects Claims 1-25 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

With respect to Claims 1, 9, 17, and 25, the *Office Action* argues that it is unclear whether the ranking of service providers is based on meeting the needs of the highest number of business function descriptions or meeting the highest number of business function requirements of a single entity. *Office Action*, p. 3. The specification clearly describes "rank[ing] each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers." P. 3. There is no indication in the claims or the specification that ranking is specific to a single entity.

With respect to Claims 2, 10, and 18, the *Office Action* argues that the phrase "if the service provider is satisfactory" is unclear as to whether the claims cite any positive limitations when the "if" statement is not fulfilled. Applicant respectfully notes that, in the context of the claims, "when" has the same meaning as "if." Thus the phrase "if the service provider is satisfactory" recites a positive limitation.

With respect to Claims 4, 12, and 20, the *Office Action* argues that the phrase "at least one negotiation threshold" is unclear as to whether it corresponds to the modified at least one deal parameter or variable service descriptors. The specification recites an example of a negotiation threshold: "For example, the business function description may include specific criteria that must be satisfied in order for particular services 18 to be considered." P. 19-20. The Examiner further argues that Claims 4, 12, and 20 are unclear in that they do not specify the point at which negotiation ends. The specification recites an example of the point at which negotiation may end: "For example, using an automated, iterative process, organization agent 22 may attempt to settle upon a relatively ideal set of purchasing criteria for purchasing particular materials." P. 19.

With respect to Claims 6, 14, and 20, the *Office Action* argues that the claims omit an essential step by reciting that “one of the satisfactory service providers ranks higher than the current service provider” without providing an initial ranking of the current service providers. Applicant respectfully submits that dependent Claims 6, 14, and 20 do provide an initial ranking of the current service providers. Dependent Claims 6, 14, and 20 include the limitations of independent Claims 1, 9, and 17, respectively, which recite “ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.” Accordingly, Applicants respectfully submit that Claims 6, 14, and 20 do not omit an essential step.

Moreover, a rejection under 35 U.S.C. § 112, second paragraph, for omitting essential steps is proper if the claim “fails to interrelate essential elements of the invention as defined by applicant(s) in the specification.” See *M.P.E.P* § 2172.01, citing *In re Venezia*, 530 F.2d 956 (C.C.P.A. 1976). The *Office Action* fails to provide any support for the contention that any omitted steps were “defined by the specification” and thus are necessary to interrelate essential elements of the invention, as required to support a rejection under 35 U.S.C. § 112, second paragraph. If the Examiner intends to maintain this rejection, Applicant respectfully requests that the Examiner cite the specific portion of the specification that defines essential elements that must be interrelated for the claims to be proper under 35 U.S.C. § 112, second paragraph.

With respect to Claim 9’s “organizational agent,” the *Office Action* argues that the system components or structure is not claimed such that one understands the structure required to carry out these steps. The specification recites: “Within organization 14, organization agent 22 handles this dynamic discovery and interaction by interfacing with service providers 12 and other elements of system 10. To perform organization management, organization agent 22 and/or organization 14 maintain a variety of information, such as plans, rule systems, and organization descriptors.” P. 8. The specification also recites: “Interface 42 provides a link between agent 40 and other entities within system 10. Depending upon the particular types of communications and configurations within system 10, interface 42 may include any suitable combination of hardware and/or logic for interacting with other components.” P. 15. Accordingly, Applicant’s specification sufficiently describes the structure required to carry out these steps.

Therefore, Applicants respectfully submit that Claims 1-25 are definite without amendment because the meaning of these claims would be clear to one of ordinary skill in the art. *See* M.P.E.P. § 2173.02. Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. MPEP §2173.04. Applicants respectfully request the Examiner to withdraw the rejection of Claims 1-25 under § 112 and allow these claims. Attorneys for Applicant stand ready to conduct a telephone conference if the Examiner would like to further discuss these issues.

II. Rejections under 35 U.S.C. § 101

The Examiner rejects Claims 9-24 under 35 U.S.C. §101 because they are directed to non-statutory subject matter.

With respect to Claims 9-16, the *Office Action* argues that the claimed service providers encompass human beings. Applicants respectfully submit that the meaning of the phrase “service providers” does not encompass human beings. The Specification provides: “Each service provider 12 represents any suitable collection of components capable of offering access to services through defined interfaces. Service providers 12 offer machine readable interfaces that enable structured queries to access and interact with information regarding services 18.” *Specification*, p. 6, ll. 14-17. Thus the phrase “service providers” cannot be interpreted to encompass human beings. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of Claims 9-16 under § 101 and allow these claims.

With respect to Claims 17-24, the *Office Action* argues that “[a] ‘computer readable medium’ is not given a definition in the specification or the claims and therefore could reasonably encompass a carrier wave signal, which is non-statutory subject matter.” *Office Action*, p. 4. Although Applicants believe that all previously pending claims recite statutory subject matter under § 101, to advance this case expeditiously to issuance, Applicants amend Claims 17-24. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of Claims 17-24 under § 101 and allow these claims.

III. Rejections under 35 U.S.C. § 103

A. Claims 1-7, 9-15, 17-23, and 25 are patentable over the *Das-Vashistha* combination.

The Examiner rejects Claims 1-7, 9-15, 17-23, and 25 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2003/0023499 to Das, et al. ("*Das*") in view of U.S. Patent Publication No. 2001/0051913 to Vashistha, et al. ("*Vashistha*"). Applicant respectfully traverses this rejection and submits that *Das* and *Vashistha*, whether taken alone or in combination, fail to teach or suggest each and every limitation of the claims.

Consider Applicant's independent Claim 1, which recites:

A method for automated management of business services comprising:
establishing an organizational database maintaining at least one business function description comprising a business function indicator and a plurality of business function requirements;
accessing a service registry using the business function indicator to identify a network address for each of a plurality of service providers each having a service indicator matching the business function indicator;
for each of the identified service providers:
communicating with the service provider to determine feature interfaces for interacting with the service provider;
accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider; and
determining whether the service provider is satisfactory based on if the service descriptors satisfy at least a portion of the business function requirements; and
ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.

Among other aspects, *Das* and *Vashistha*, whether taken alone or in combination, fail to teach or suggest: (1) accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider; and (2) ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.

i. The proposed combination fails to teach or suggest accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider.

Claim 1 requires "accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the

service provider.” As teaching these aspects, the *Office Action* relies on *Das*, paragraphs 47, 48, 50, 52, and 68. In general, *Das* discloses a system for automatically making operational purchasing decisions. In the cited portion, *Das* provides, “[e]ach time a counteroffer is received, the purchasing system determines whether it is acceptable, using its internal rules and parameters.” *Das*, ¶ 68. The *Office Action* equates *Das*’s parameters to the claimed service descriptors and argues that “parameters are used to negotiate the purchase from sellers, therefore, negotiation involves determining descriptors provided by the provider.” *Office Action*, p. 5. The *Office Action*, however, provides no basis in fact and/or technical reasoning to support its mere assertions that *Das*’s parameters teach the claimed service descriptors and that using *Das*’s parameters teaches determining service descriptors, as recited in Claim 1. “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” M.P.E.P. § 2112; see *In re Robertson*, 49 U.S.P.Q.2d 1949, 1150-51 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Accordingly, *Das* fails to teach or suggest “accessing at least one of the feature interfaces of the service provider to determine a plurality of service descriptors describing a service provided by the service provider,” as Claim 1 requires. *Vashistha* fails to remedy the deficiencies of *Das*.

Independent Claims 9 and 17 include limitations that, for substantially similar reasons, are not taught by *Das* and *Vashistha*. Because *Das* and *Vashistha* do not teach or suggest every element of independent Claims 1, 9, and 17, Applicant respectfully requests reconsideration and allowance of Claims 1, 9, and 17 and their respective dependent claims.

ii. The proposed combination fails to teach or suggest ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.

Claim 1 requires “ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers.” As teaching these

aspects, the *Office Action* relies on *Vashistha*, paragraph 41. In the cited portion, *Vashistha* recites “an intelligent bid selection engine configured to score and rank the provider bids based on buyer specified selection criteria.” ¶ 41. Applicant assumes the *Office Action* equates *Vashistha*’s “buyer specified selection criteria” to the claimed “service descriptors.” However, *Vashistha*’s “buyer specified selection criteria” fail to teach or even suggest “service descriptors describing a service provided by the service provider,” as Claim 1 requires. Accordingly, *Vashistha* does not teach or suggest “ranking each of the satisfactory service providers based on the service descriptors from each of the satisfactory service providers,” as Claim 1 requires. *Das* fails to remedy the deficiencies of *Vashistha* (as the Examiner appears to agree, *Office Action*, pp. 5-6).

Independent Claims 9 and 17 include limitations that, for substantially similar reasons, are not taught by *Das* and *Vashistha*. Because *Das* and *Vashistha* do not teach or suggest every element of independent Claims 1, 9, and 17, Applicant respectfully requests reconsideration and allowance of Claims 1, 9, and 17 and their respective dependent claims.

B. Claims 8, 16, and 24 are patentable over the *Das-Vashistha-Chun* combination.

The Examiner rejects Claims 8, 16, and 24 under 35 U.S.C. §103(a) as unpatentable over *Das* in view of *Vashistha* in further view of U.S. Publication No. 2002/0184527 to Chun et al (“*Chun*”). As described above, Applicant has shown that *Das* and *Vashistha* fail to disclose all limitations of independent Claims 1, 9, and 17. Accordingly, *Das* and *Vashistha* fail to teach or suggest all limitations of Claims 8, 16, and 24 because these dependent claims incorporate the limitations of their respective independent claims. *Chun* fails to remedy the deficiencies of *Das* and *Vashistha*.

Thus, *Das*, *Vashistha*, and *Chun*, whether taken alone or in combination, fail to teach or suggest all limitations of Claims 8, 16, and 24. Because the references fail to teach all limitations of the claims, Applicant respectfully requests reconsideration and allowance of Claims 8, 16, and 24.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of this Application.

If the Examiner feels prosecution of the present Application may be advanced by a telephone conference, Applicant invites the Examiner to contact the undersigned attorney at (214) 953-6584.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'Kurt M. Pankratz', with a long horizontal flourish extending to the right.

Kurt M. Pankratz
Reg. No. 46,977

Date: July 24, 2008

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